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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,732	06/28/2001	Noboru Iwayama	1405.1045	3572

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EXAMINER	
LE, KHANH H	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,732	IWAYAMA ET AL.	
	Examiner	Art Unit	
	Khanh H. Le	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12, 14-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the correspondence received May 08, 2006.

Claims 1-12, 14-15 were pending. Claim 13 is cancelled. Claims 1, 2, 9, 10, 11, 12, 14-15 are independent.

Specification

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

(1) if a machine or apparatus, its organization and operation;

(2) if an article, its method of making;

(3) if a chemical compound, its identity and use;

(4) if a mixture, its ingredients;

(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The previous objection is withdrawn in view of the amendment , however the abstract is now objected to as not including that which is new in the art to which the invention pertains as stated above because the allegedly novel part (i.e. sending to a second buddy user ad data in response to browsing from 1st user) has been deleted.

Claim Rejections - 35 USC § 101

4. Previous rejection of claim 9 under this section is withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5a. Previous rejections to claims 1-8, 13-15 are rejected under 35 U.S.C. 112, second paragraph, under this section, are withdrawn.

5b. Claims 1 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1:

Step d) " *receiving from at least one said computers a selection of at least one of the resource identification information and the advertising information in said recording*" is confusing.

Applicants' response ,at page 10, indicates that the receiving is from one of the user computers .

However, if it is receiving a resource identification information from the 1st user, this step seems redundant with the next step e) of detecting resource identification information in use by the 1st user.

If it is receiving from the 2nd user advertising information (e.g. further details re. the icon representing status of 1st user),the phrase is confusing because the step seems out of order as it should logically follow step f) broadcasting to the 2nd user etc....

Step d) can also be interpreted as receiving , from advertisers' computers and not from users computers, data so to correlate, in the database, resource identification information to advertising information. Which seems to be redundant with step c).

(This interpretation seems plausible in view of the same language used in claims 2-4 claiming "receiving from the computers" registered and unregistered ads, apparently from advertisers ("owners' in claim 3) .)

Since step d) covers many possibilities some of which render the claim internally contradictory , the claim scope is unclear almost to the point that no prior art can be applied.

See In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

Appropriate correction is required.

For prior art application purposes, it is taken that step d) means receiving a resource identification information from the 1st user, i.e. similar to step e) .

Claim 14: "to the second computer" lacks antecedent basis.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-4, 9,10, 12, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirmse et al., US 6699125 B2.

As to claim 1 , Kirmse discloses
A method for advertisements broadcasting and displaying (see Fig 7, 9: game logos or icons are ads image data) to user-operated, network-interconnected computers including a first computer operated by a first user and a second computer operated by a second user (see Network of Fig. 1) , the method including:
a) administrating status of users including the first user and
the second user (see abstract, Fig 1, items 12(2), 18, 22(1) ; Fig 9 and associated text: messenger clients, server, buddy lists) ;

b) receiving from the first computer (Fig 1, item 12(1)) and broadcasting to the second computer (Fig 1, item 12(2)) the status of the first user (see abstract, Fig 1, items 12(2), 18, 22(1) ; Fig 9 and associated text: messenger clients, server, buddy lists) ;

d) receiving from at least one said computers a selection of at least one of the resource identification information and the advertising information in said recording;

(**Interpretation of step d)**: Applicants' response ,at page 10, indicates that the receiving is from one of the user computers , thus herein it is taken that step d) means receiving a resource identification information from the 1st user, i.e. similar to step e).

(col.1 lines 45-52 ;col. 8 l. 55-60: online game identification (or "resource identification information") used by 1st user is implicitly first selected by user then detected so to notify buddies which game he's playing);

Note:

(If on the other hand step d) is interpreted as receiving from the 2nd user advertising information (e.g. further details regarding the icon representing status of 1st user),Kirmse discloses the 2nd user getting more information about the game advertised by the icon and the text of "Dumb Chat" (col. 9 lines 43-46; Fig. 10))

e) detecting resource identification information for a first resource in use by the first user (col.1 lines 45-52 ;col. 8 l. 55-60: online game URL used by 1st user is detected so to notify buddies which game he's playing) ;

f) extracting from the advertising information recorded in said recording *said* first advertising information (see Figs 7, step S201; the game specific icon is an image associated with that game and serves to represent the game and to invite others to join the game, thus it is an " advertising image data" as claimed; Fig 9 : game specific icon of " dumb Chat" to left of Tom123494949's name) corresponding to the resource identification information for the first resource, detected in said detection (col.5 lines 59-67; col. 6 lines 33-35: each game currently being played (i.e. browsed) can be uniquely identified)

g) broadcasting to the second computer said first advertising information extracted in said extraction step (see Figs 7, step S201; Fig 9 and associated text) and

h) displaying as status of the first user on the second computer said status represented by advertising image data included in said first advertising information broadcast, said displaying in response to browsing by said 1st computer (see Figs 7, step S201; the game specific icon is an image associated with that game and serves to represent the game and to invite others to join the game, thus it is an " advertising image data" as claimed; Fig 9 : game specific icon of " dumb Chat" to left of Tom123494949's name indicating Tom is currently playing that game)

As to step c) "correlatively recording in an advertising database resource identification information specifying a resource on the network with advertising information including image data for the advertisements",

Kirmse does not specifically disclose that the identifier (e.g. the URL) of the game being currently played by user #1 is correlated to the ad information (e.g. the icon representing the game) about the site (the game) in a correlative database as claimed. However, Kirmse at least suggests the ad data (game specific icon) is looked up from a correlative database located on the game data server (col. 13 lines 6-53)). Further, Official Notice is taken that such correlation method is well-known and therefore obvious to be implemented in Kirmse to effect associating the relevant game icons with the games which have been identified as being currently played as taught by Kirmse (see Fig 9).

Claims 10, 12, and 14 are broader claims than claim 1. The features of Kirmse discussed in claim 1 read on these claims thus they are rejected on the same basis as claim 1.

As to claims 2, 4 and 9, the features common to claim 1 are disclosed as discussed above..

Interpretation: "receiving ... from the computers" is taken as receiving from the advertisers' computers.

Kirmse does not specifically disclose receiving new (unregistered) ads information from these advertisers and designations of already registered resources.
However, Official Notice is taken that accepting new (unregistered) information from clients and correlating new information with other clients' data already belonging to the same clients is well-known in order to correlatively update the clients' existing data with new data.

Thus it would have been obvious to one skilled in the art at the time the invention was made to add these customary methods to the system of Kirmse above (with the game owners being the equivalent of the claimed advertisers) to allow adding new advertising data [such as new details of the game (detailed information about the game advertised by the icon is disclosed at col. 9 lines 43-46; Fig. 10), or new icons] to the ad resources (e.g. the game URL's in Kirmse), in the correlative database to allow updating the data associated with the games (e.g. icons, further details) for the players' benefit.

As to claim 3, the features common to claim 2 are disclosed as discussed above.

Kirmse does not specifically disclose communicating with clients using their addresses, to ask their permission to correlate the new information with certain existing data already registered as belonging to them, and with their permission, so perform the correlation, as claimed. However Official Notice is taken that asking permission in such situations is customary to ensure correct correlation of data, secure client authorization and thus their satisfaction. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to add such customary methods to Kirmse for the above-discussed advantage.

Claim 15, much broader than claim 1, is disclosed by the Kirmse's features disclosing claim 1 as discussed above.

Further Kirmse discloses status of the 1st user, shown as a game specific icon (ad image data) distributed to a list of buddies ((Figs. 7 and 9 and associated text).

8. Claims 5-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over as applied to claim 4 above, and further in view of Recommend-it, (a set of 3 documents as listed below, dated back to 1998), and Goldhaber et al., US 5,794,210.

As to claim 5-8, the steps of a user requesting detailed information associated with the ad sent, returning the detailed information if available are taught by Kirmse (Fig. 10: "more information on Dumb Chat"; col. 9 lines 43-46).

However, Kirmse does not disclose monitoring access to the ads detailed information from the user, setting awards conditions set for the user based on access to ads, doling out awards as earned, monitoring access counts to detailed ads information, calculating fees to charge advertisers based on the user access.

However,

, **"Want to See What We Can Do For Your Website? Click The Button To Test Us Out! " at Recommend-it.com , http:// web.archive.org/web/19980610011830/www.recommend-it.com/, (4 pages, dated back to 1998), herein "Recommend-it document #1",** discloses a system where a website (such as www.webdeck.com) browsed by a 1st user (e.g." Eileen Velet") is detected and an email, disclosing the status of the 1st user ("velvet wants to you to check this site out") is sent to buddies of the 1st user indicating the website just visited by this user (see page 2 , left frame lines 5-7) ,and links to that website so the buddy can visit (see page 4, line 8) . Included in the

email is description of the site and other "juicy details" of the site so that the "friend or colleague will see exactly what the site contains before they visit" (see page 4 of 4). The description of the site and the juicy details of the site constitute an advertisement for the site to entice the buddy to visit.

Recommend-it teaches that messages to buddies inviting them to join a game are opportunities for advertising. The " juicy details" ad about the game in Recommend-it above are the equivalent of the further details of the game taught in Kirmse Fig 10.

Recommend it further adds more ads in the invitation message (see at page 4, the financial ad "Green Mountain Asset" tagged to the email message). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to add such additional ads to Kirmse in order to generate ad revenues to sustain a free service as taught in Recommend it (page 4 line 28: "we have to eat").

(Note: further relevant teachings from Recommend it, http:// web.archive.org/web/19980610011837/www.recommend-it.com/user_reg.user_regHTML.fcgi, herein" Recommend-it document #2", (2 pages) shows setting up buddy lists to send recommended site identifiers to.

"Advertising rates" at Recommend-it.com, http:// web.archive.org/web/19980610011859/www.recommend-it.com/html/advert.html, herein" Recommend-it document #3", (3 pages) discloses solicitation of advertisers, advertising pay rates, advertising URL's in emails to recommend sites identified by the URL's.)

As to the steps of monitoring access to the ads detailed information from the user, setting awards conditions set for the user based on access to ads, doling out awards as earned, monitoring access counts to detailed ads information, calculating fees to charge advertisers based on the user access, they are not specifically disclosed Recommend-it either (though Recommend-it suggests monitoring to charge advertisers). However these steps are all disclosed either in Goldhaber (see at least abstract, Figs. 1-15 and associated text) or as admitted art in the Specifications (see at least pages 2-3) .

It would have been obvious to one skilled in the art at the time the invention was made to add the methods of ad viewing rewards and charging of advertisers taught Goldhaber or admitted, to the advertising system/method of Kirmse/ Recommend-it to effect the ad compensation/ charge scheme as taught by Goldhaber or admittedly known, to further encourage ad viewing.

Claim 11 is interpreted as a combination of claims 1-8 wherein the incentives are given to the 2nd (consulting) user.

As discussed above, Kirmse at least suggests the ad data (icon) is looked up from a correlative database (col. 13 lines 6-53) and Kirmse discloses the 2nd user getting more information regarding the advertised game (col. 9 lines 43-46).

It would have been obvious to one skilled in the art at the time the invention was made, in view of the Kirmse/ Recommend-it system of together playing games users, who also are potential consumers of other goods and services, and in view of Goldhaber's compensation scheme, to add rewarding the consulting user to the Kirmse /Recommend-it system, to encourage ads viewing as taught by Goldhaber.

Response to Arguments

8. Applicant's main arguments with respect to claims 1-12, 14-15 have been considered but are moot in view of the new ground(s) of rejection.

Challenges to Official Notices

9. MPEP 2144.03 states: "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which See 37 CFR would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or the traverse was inadequate. .."

At page 13, Applicants challenge the Official Notices, yet did not specify which notices are challenged or the specific supposed errors, thus the traversals are inadequate and the notices are taken as admitted.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular

communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 17, 2006

KHL

KHL

RAQUEL ALVAREZ
PRIMARY EXAMINER